



*The Intellectual Property Law Section of the State Bar of California presents the*

# 29th Annual Intellectual Property Institute

## November 5-6, 2004

Disney's Grand Californian Hotel®

1600 South Disneyland Drive | Anaheim, CA 92802 | (714) 520-5005



- Register online by visiting [www.calbar.ca.gov/ipsection](http://www.calbar.ca.gov/ipsection)
- Enjoy an Exceptional Line-Up of Topics and Speakers Presenting on Substantive IP Topics, Ethics, IP Insurance and More!
- Earn up to 14.5 hours of MCLE credit.
- Network, Share Ideas and Learn the Latest with Intellectual Property Professionals with Diverse Experience and Backgrounds.
- A full 2-days of Education for a nominal fee of \$495 for members of the Intellectual Property Law Section which includes Education Programs, Program Materials, Friday and Saturday Continental Breakfasts and Luncheons and the Friday Night Reception.

*The State Bar of California and the Intellectual Property Section of the State Bar of California are approved MCLE Providers.*

### Sponsors:

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# Programs at a Glance

Friday, November 5, 2004

## TRACK I – Patents

PTO: Patent Office Practice Update

Patenting of Art and Media Concepts

Effective Enforcement Strategies of Patent Rights for U.S. Inventors in Europe

Valuation of Intellectual Property

Open Source: What Every IP Lawyer Should Know About This Pervasive Paradigm

Software Business Method Patents: A Ghost in the Machine?

Patents on Discoveries in the Life Sciences

## TRACK II – Mixed-1

Filling Strategies for Foreign Trademarks: Multiple Choice in the Global Market

Geographic Indicators of Origin

Developments in Trademark Law and the Internet: Domain Name Disputes, Banner Ads, Pop-Ups and Related Issues

What Franchise Lawyers Need from Trademark Counsel

Mediation & Arbitration of Trademarks

Licensing IP: How to Mine It, How to Package It and How to License It

Finding, Preparing and Using Consultants and Expert Witnesses in IP Litigation and IP Trials

Saturday, November 6, 2004

## TRACK III – Litigation

Patent Litigation Rules and Tactics in the California District Courts

IP Litigation in State Court v. Federal Court

All Rise: Court Is Now in Session for Trade Secret Litigation

IP Practice Before the International Trade Commission

The Economics of Patent Infringement Damages: Rigorous Techniques and Lessons to be Learned from Transfer Pricing

Securing the Verdict–Top Ten IP Trial Strategies

## TRACK IV – Mixed-2

IP Insurance–Discussion of Types, Common Provisions, Costs and Who Provides

Successfully Managing IP Risks

Rainmaking for IP Practitioners

Malpractice Myths and Realities: Managing and Insuring the Professional Risks of Intellectual Property Firms

Trust and Ethics in IP Practice

Types and Tips for Avoiding Malpractice Claims: War Stories from Malpractice Litigators



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# Schedule of Events

## Thursday, November 4, 2004

**10:00a.m. – 4:30p.m.**

Executive Committee Meeting

**7:00p.m. – 10:00p.m.**

Annual Executive Committee Alumni and Speakers' Reception & Dinner

## Friday, November 5, 2004

**7:00a.m. – 7:45a.m.**

Continental Breakfast, Conference Registration & MCLE Sign-in

**7:45a.m. – 8:00a.m.**

Track I – Patents

Opening Remarks

Track II – Mixed-1

Opening Remarks

**8:00a.m. – 9:00a.m.** (1 Hour MCLE Credit)

Track I – Patents

**PTO: Patent Office Practice Update**

*Speaker:* Stefan J. Kirchanski, Ph.D., Liner Yankelevitz Sunshine & Regenstreif, LLP (Los Angeles)

Track II – Mixed-1

**Filling Strategies for Foreign Trademarks: Multiple Choice in the Global Market**

*Moderator:* Christine L. Kopitzke, Hatch & Parent (Santa Barbara)

*Speakers:* Lawrence A. Maxham, The Maxham Firm (San Diego)

Matthew A. Powelson, LaRiviere Grubman & Payne LLP (Monterey)

## Friday, November 5, 2004 (continued)

**9:00a.m. – 10:00a.m.** (1 Hour MCLE Credit)

Track I – Patents

**Patenting of Art and Media Concepts**

*Speaker:* Gregory A. Aharonian, Internet Patent News Service (San Francisco)

Track II – Mixed-1

**Geographic Indicators of Origin**

*Speaker:* Professor Jed Scully, University of the Pacific, McGeorge School of Law (Sacramento)

**10:15a.m. – 11:15a.m.** (1 Hour MCLE Credit)

Track I – Patents

**Effective Enforcement Strategies of Patent Rights for U.S. Inventors in Europe**

*Speaker:* David Molnia, Dorries, Frank, Molnia & Pohlman (Munich, Germany)

Track II – Mixed-1

**Developments in Trademark Law and the Internet: Domain Name Disputes, Banner Ads, Pop-Ups and Related Issues**

*Speaker:* Philip J. Graves, Liner, Yankelevitz, Sunshine & Regenstreif, LLP (Los Angeles)

**11:15a.m. – 12:15p.m.** (1 Hour MCLE Credit)

Track I – Patents

**Valuation of Intellectual Property**

*Speaker:* Christian Tregillis, Kroll, Zolfo & Cooper (Los Angeles)

Track II – Mixed-1

**What Franchise Lawyers Need from Trademark Counsel**

*Speaker:* Robin Day Glenn, Franchise Law Team (Rancho Santa Margarita)



# Schedule of Events

## Friday, November 5, 2004 (continued)

### 12:15p.m. – 1:45p.m.

#### Standing Committee Luncheon Meetings

Each Standing Committee meeting listed below is open to any Institute registrant. Please select the committee luncheon you wish to attend by checking the appropriate box on the registration form.

Computer Law, Copyright Law, Patent Law, Trade Secret Law, Trademark Law and Diversity

### 1:45p.m. – 2:45p.m. (1 Hour MCLE Credit)

#### Track I – Patents

##### Open Source: What Every IP Lawyer Should Know About This Persuasive Paradigm

**Speakers:** Michael M. Krieger, Ph. D., UCLA Computer Science Department (Los Angeles)  
Jason H. Wilson, Willenken, Wilson, Loh & Stris, LLP (Los Angeles)  
Richard C. Hsu, Townsend Townsend and Crewe, LLP (Palo Alto)

#### Track II – Mixed-1

##### Mediation & Arbitration of Trademarks

**Speaker:** Robert S. Gerber, Sheppard, Mullin Richter & Hampton, LLP (San Diego)

### 2:45p.m. – 3:45p.m. (1 Hour MCLE Credit)

#### Track I – Patents

##### Software & Business Method Patents: A Ghost in the Machine?

**Speakers:** Colbern Stuart, Paul Hastings Janofsky & Walker, LLP (San Diego)  
Jason Schultz, Electronic Frontier Foundation (San Francisco)  
Daniel P. McCurdy, ThinkFire (Clinton, NJ)

#### Track II – Mixed-1

##### Licensing IP: How to Mine It, How to Package It and How to License It

**Speaker:** Joseph J. Cote, Rockwell Science Center Licensing Company (Thousand Oaks)

### 4:00p.m. – 5:00p.m. (1 Hour MCLE Credit)

#### Track I – Patents

##### Patents on Discoveries in the Life Sciences

**Speaker:** D. Benjamin Borson, Ph.D., Fliesler, Dubb, Meyer & Lovejoy, LLP (San Francisco)

#### Track II – Mixed-1

##### Finding, Preparing and Using Consultants and Expert Witnesses in IP Litigation and IP Trials

**Speakers:** Paul J. Loh, Willenken, Wilson, Loh & Stris, LLP (Los Angeles)  
Peter K. Stris, Willenken, Wilson, Loh & Stris, LLP (Los Angeles)  
Robert J. Benson, Hogan & Hartson, LLP (Los Angeles)

### 5:00p.m. – 6:30p.m.

#### Cocktail Reception

## Saturday, November 6, 2004

### 7:30a.m. – 8:00a.m.

Continental Breakfast, Conference Registration & MCLE Sign-in

### 8:00a.m. – 8:15a.m.

#### Track III – Litigation

##### Opening Remarks

#### Track IV – Mixed-2

##### Opening Remarks



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## Saturday, November 6, 2004 (continued)

### 8:15a.m. – 9:45a.m. (1.5 Hours MCLE Credit)

Track III – Litigation

**Patent Litigation Rules and Tactics in the California District Courts—Using Early Discovery Rules, Markman Hearing Procedures and Court Directed Settlement Conferences to Manage and Budget Your Case**

*Speakers:* Stephen S. Korniczky, Paul Hastings Janofsky & Walker, LLP (San Diego)

Track IV – Mixed-2

**IP Insurance—Discussion of Types, Common Provisions, Costs and Who Provides**

*Speakers:* Manny Cho, Carpenter, Moore (San Francisco)

Paul Palkovic, Bolton & Company (Oxnard)

Ronald C. Wanglin, Bolton & Company (Oxnard)

### 9:45a.m. – 10:45a.m. (1 Hour MCLE Credit)

Track III – Litigation

**IP Litigation in State Court v. Federal Court**

*Speakers:* Gary J. Gorham, Liner Yankelevitz, Sunshine & Regenstreif, LLP (Los Angeles)

Robert J. Shilliday, III, Townsend Townsend and Crewe, LLP (San Francisco)

Scott H. Carr, Greene, Broillet, Panish & Wheeler, LLP (Santa Monica)

Track IV – Mixed-2

**Successfully Managing IP Risks**

*Speakers:* Kimberly K. Cauthorn, Marsh USA, Inc. (Houston, TX)

JoAnna M. Esty, Liner Yankelevitz, Sunshine & Regenstreif, LLP (Los Angeles)

### 11:00a.m. – 12:00noon (1 Hour MCLE credit)

Track III – Litigation

**All Rise: Court Is Now in Session for Trade Secret Litigation**

*Speakers:* Rebecca J. Edelson, Alschuler Grossman Stein & Kahan, LLP (Santa Monica)

Randall E. Kay, Gray Cary Ware & Friedenrich, LLP (San Diego)

Hon. Mark Snauffer, Fresno County Superior Court (Fresno)

Track IV – Mixed-2

**Rainmaking for IP Practitioners**

*Moderator:* F. David LaRiviere, LaRiviere Grubman & Payne (Monterey)

*Speakers:* David M. Tognotti, Monster Cable Products (Brisbane)

Pascal DiFronzo, Autodesk (San Rafael)

Robert R. Nielsen, Tanimura & Antle (Salinas)

### 12:00noon – 1:30p.m. (.5 Hour MCLE Credit)

Luncheon & Keynote Presentation

**How Lawyers and Judges Can Increase Jurors' Comprehension of Complex IP Cases**

*Speaker:* Judge Ronald M. Whyte, U.S. District Court for the Northern District of California (Santa Clara)

### 1:30p.m. – 3:00p.m. (1.5 Hours MCLE Credit)

Track III – Litigation

**IP Practice Before the International Trade Commission**

*Speakers:* Patrick P. DeGravelles, Miller & Chevalier Chartered (Washington, D.C.)

Sturgis M. Sobin, Miller & Chevalier Chartered (Washington, D.C.)

Track IV – Mixed-2

**Malpractice Myths and Realities: Managing and Insuring the Professional Risks of Intellectual Property Firms**

*Speakers:* Paul E. Dorroh, Marsh Affinity Group Services (San Francisco)

John E. Hurley, Jr., Retired Partner, Bingham McCutchen, LLP (San Francisco)

### 3:15p.m. – 4:15p.m. (1 Hour MCLE Credit)

Track III – Litigation

**The Economics of Patent Infringement Damages: Rigorous Techniques and Lessons to be Learned from Transfer Pricing**

*Speaker:* Ken Serwin, Ph.D., NERA Economic Consulting (San Francisco)

(1 Hour Legal Ethics Credit)

Track IV – Mixed-2

**Trust and Ethics in IP Practice**

*Speakers:* Professor Linnea McCord, The Graziadio School of Business, Pepperdine University (Encino)

D. Benjamin Borson, Ph. D., Fliesler Dubb Meyer & Lovejoy, LLP (San Francisco)

### 4:15p.m. – 5:15p.m. (1 Hour MCLE Credit)

Track III – Litigation

**Securing the Verdict – Top Ten IP Trial Strategies**

*Moderator:* Craig E. Holden, Robins Kaplan Miller & Ciresi, LLP (Los Angeles)

*Speakers:* David W. Beehler, Robins Kaplan Miller & Ciresi, LLP (Minneapolis, MN)

Jan M. Conlin, Robins Kaplan Miller & Ciresi, LLP (Minneapolis, MN)

Track IV – Mixed-2

**Types and Tips for Avoiding Malpractice Claims: War Stories from Malpractice Litigators**

*Speakers:* Pamela A. Bresnahan, Vorys, Sater, Seymour & Pease (Washington, D.C.)

Bruce A. Broillet, Greene, Broillet, Panish & Wheeler, LLP (Santa Monica)

Conference Adjourns

# Registration Information

*The Intellectual Property Section welcomes all who are interested in Intellectual Property. You need not be a lawyer to attend, enjoy and benefit from this program.*

## Registration Fees:

Registration fees include admission to 14.5 hours of MCLE instruction, course materials, continental breakfasts, luncheons and the Friday evening reception. Registration fees are \$495 for IP Section members, \$595 for non-members and \$215 for law school faculty or students.

## Three Ways to Register:

Registration deadline: **November 1, 2004**

**Online:** Register online by visiting [www.calbar.ca.gov/ipsection](http://www.calbar.ca.gov/ipsection)

**Fax:** You may fax your registration form to Program Registrations at (415) 538-2368. All faxed registrations must be accompanied by a signature and MasterCard or VISA card number.

**Mail:** Mail registration form and check made payable to the State Bar of California or credit card information to: Program Registrations, The State Bar of California, 180 Howard St., San Francisco, CA 94105.

## Cancellations:

All requests for refunds must be received in writing no later than November 1, 2004. Refunds will be issued less a \$50 non-refundable administrative cost. Refunds will not be available after the November 1<sup>st</sup> deadline; however, registration substitutions are welcome.

## Special Assistance:

Please call (415) 538-2585 for special assistance or TDD (415) 538-2231 for speech and hearing impaired.

## Airline Discounts:

The State Bar of California has a discount program with United Airlines. To make reservations, or for additional information, please call the United Group Meeting Desk at (800) 521-4041 and refer to file number 550QX.

## Discount Disneyland Park and Disney's California Adventure Park Tickets:

As an IP Institute attendee, you can purchase discount Disney tickets at: [conventionplus.com/dlr](http://conventionplus.com/dlr). You must allow at least 10 calendar days prior to your date of departure to Disneyland® Resort for order processing, shipping and delivery of your tickets. **Special pricing is available ONLY with your advance, pre-arrival purchase. Box office tickets will be available at the Disneyland® Resort Main Gate Ticket Booths at REGULAR prices.**

## Hotel Reservations:

We have a reserved a block of sleeping rooms at Disney's Grand Californian Hotel® in Anaheim. Please contact the hotel directly at (714) 520-5005 to make your reservation at the group rate of \$239 per night plus tax. Please make your reservation by October 18, 2004. Please remember to identify yourself as attending the State Bar Intellectual Property Institute.

## Information:

For more information, please call the Intellectual Property Section at (415) 538-2375. For registration information, please call program registrations at (415) 538-2508.



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# Registration Form

Registration Deadline: November 1, 2004

## Three Ways to Register:

**Online:** Register online by visiting  
[www.calbar.ca.gov/ipsection](http://www.calbar.ca.gov/ipsection)

**Fax:** You may fax your registration form to  
Program Registrations at (415) 538-2368.  
All faxed registrations must be accompanied by a  
signature and MasterCard or VISA card number.

**Mail:** Mail registration form and check made payable to the  
*State Bar of California* or credit card information to:  
Program Registrations, The State Bar of California,  
180 Howard St., San Francisco, CA 94105

Bar Number: \_\_\_\_\_

Name: \_\_\_\_\_

Badge Name: \_\_\_\_\_

Firm Name: \_\_\_\_\_

Address: \_\_\_\_\_

City, State & Zip: \_\_\_\_\_

Phone: \_\_\_\_\_

Fax: \_\_\_\_\_

E-mail: \_\_\_\_\_

Guest: \_\_\_\_\_

*(Note: If your guest is a non-attorney, registration is complimentary. Attorney guests must complete a separate registration form and pay the appropriate registration fee.)*

**\*\* Your name and address may be disclosed to other IP Institute attendees and exhibitors/vendors.**

I have a special diet and will need:

- ☐ Vegetarian Meals
- ☐ Low Carb Meals

## Registration Fees:

- ☐ IP Section Members - \$495
- ☐ Non-Members of the Intellectual Property Section - \$595  
*(includes enrollment in the Intellectual Property Law Section for 2005)*
- ☐ Law School Faculty and students - \$215

Subtotal of Registration Fee \$ \_\_\_\_\_

## Special Events:

Friday Committee Luncheon

- ☐ I will attend (FREE)  
*(indicate which Committee luncheon you will attend)*

- ☐ Copyright Law
- ☐ Computer Law
- ☐ Patent Law
- ☐ Trademark
- ☐ Trade Secret
- ☐ Diversity
- ☐ Undecided/I will not attend

Friday Cocktail Reception (complimentary)

- ☐ I will attend (FREE)
- ☐ I will not attend

Saturday Luncheon (free for PAID registrants)

- ☐ I will attend (FREE)
- ☐ I will not attend

Number of Guests for the Saturday Luncheon  
\_\_\_\_\_ @ \$35 = \$ \_\_\_\_\_

Subtotal of Special Events Fee \$ \_\_\_\_\_

Total Amount Enclosed or to be Charged \$ \_\_\_\_\_

## Payment Method:

Registration fees may be paid by check, VISA or MasterCard.  
No other credit cards will be accepted. Make checks payable to  
the *State Bar of California*.

- ☐ VISA
- ☐ MasterCard

Account Number: \_\_\_\_\_

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FOR REGISTRATION INFORMATION PLEASE CALL  
(415) 538-2508





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